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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William Stuart Somers *et al.* Art Unit : 1646
Serial No. : 09/903,876 Examiner : M. Pak
Filed : July 11, 2001
Title : CRYSTAL STRUCTURE OF ESTROGEN RECEPTOR-BETA COMPLEX AND
USES THEREOF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF FEBRUARY 8, 2005

In response to the Office Action mailed February 8, 2005, Applicants request consideration of the following comments.

35 U.S.C. §101

The Examiner maintained the prior rejection of claims 7-13, and further rejected claims 16 and 17, under 35 U.S.C. §101. The Examiner did not consider Applicants' prior arguments, apparently because Applicants did not provide the Examiner a copy of the Trilateral report. Applicants do not believe that they have the burden of providing a copy of the Trilateral report to the Examiner, at least because the U.S.P.T.O. itself published the Trilateral Report. Applicants ask that the Examiner obtain a copy of the Trilateral report from the U.S.P.T.O. website at http://www.uspto.gov/web/tws/wm4/wm4_index.htm.

In view of the arguments Applicants' previously presented, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C §101.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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5/5/05

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35 U.S.C. §112

The Examiner maintained the rejection of claims 7-13, and further rejected claims 16 and 17, under 35 U.S.C. §112, first paragraph for failing to satisfy the written description requirement.

The claims cover crystal structures having a resolution of 1.83Å or less. The application as originally filed discloses a crystal structure. *See*, Example 1, at pages 15-22. The application generally discloses that the crystal is a "1.8 Å crystal structure," (page 15, paragraph 37) and more specifically discloses that the crystal structure has a resolution of 1.83-1.8 Å. *See*, page 21, Table 1. In view of this disclosure, one skilled in the art would understand that Applicants had possession of crystal structures having a resolution of 1.83 Å or less. Applicants therefore request reconsideration and withdrawal of the rejection of claims 7-13, 16 and 17 under 35 U.S.C. §112, first paragraph.¹

35 U.S.C. § 103(a)

The Examiner rejected claims 7-13, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Ljunggren in view of Donner. However, neither Ljunggren nor Donner, alone or in combination, disclose or suggest the methods covered by the claims, and there is no suggestion to combine the references to provide the methods covered by claims 7-13, 16 and 17. Furthermore, neither Ljunggren nor Donner, alone or in combination, enable the methods covered by these claims. But, as explained by the United States Court of Appeals for the Federal Circuit in Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551 (Fed. Cir. 1989):

In order for the prior art to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.

¹ For the reasons noted above, Applicants believe that the related provisional application also satisfies the written description requirement.

Ljunggren discloses a crystal of ER- β , but the crystal has a resolution of greater than 1.83 Å. Ljunggren provides absolutely no guidance regarding how to make a crystal of ER- β with a resolution of 1.83 Å or less.

Donner does not even disclose a crystal of ER- β . Further, while Donner states that a crystal of human androgen receptor (hAR) “[p]referably has a resolution of from about 1.5 Å to about 3.5 Å” (Donner *et al.*, p. 6, par. 87), the hAR crystal generated by Donner’s methods only had a resolution to 2.4 Å. *See*, Donner *et al.*, p. 21, Table 1. Thus, beyond not even disclosing how to make a crystal of ER- β , Donner does not disclose how to make a crystal of any type with a resolution of 1.83 Å or less.

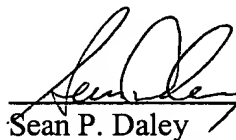
In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 7-13, 16 and 17 under 35 U.S.C. § 103(a).

Applicants believe the application is in condition for allowance, which action is requested.

No fees are believed to be due. However, please apply any necessary charges or credits to deposit account 06-1050, with reference to Attorney Docket No. 16163-005001.

Respectfully submitted,

Date: 5/5/05


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